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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,452	12/13/1999	TIMO TAPANI TOKKONEN	NC24603	1166

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EXAMINER

RAMOS FELICIANO, ELISEO

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/459,452

Applicant(s)

TOKKONEN, TIMO TAPANI

Examiner

Eliseo Ramos-Feliciano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-20 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-20 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 2, 2004 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim first recites "storing said reminder in the system" (line 3) and "storing an indication of said external triggering event in the system" (line 7), then it recites "the indication of said triggering event and the reminder [...] once stored, in the communication device" (line 9). It is not clear whether these are stored in the system, external to the communication device or inside the communication device itself.

The claim further recites "defining an action and storing an indication of said action in the system, the action associated with the reminder and the action, once stored, indexed together with the triggering event and the reminder" (lines 10-12). It is not clear whether the action, the indication, the triggering event and the reminder are stored in the system, external to the

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communication device or inside the communication device itself. Furthermore, the recitation "the action associated with the reminder and the action" is not clear.

4. **Claims 1, 10, 13, and 23** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite "external triggering event", "triggering event" and "external event" indistinctively. There is no consistency on the term.

For example *claim 1* recites the limitation "said triggering event" in line 8, etc. *Claim 13* recites the same limitation in line 2. There is insufficient antecedent basis for this limitation in the claim.

For example *claim 10* recites the limitation "said step of defining a triggering event" in line 3; also "the external event" in line 2. There is insufficient antecedent basis for this limitation in the claim.

For example *claim 23* recites the limitation "the external event" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-5, 10-18, 23-26** are rejected under 35 U.S.C. 102(b) as being anticipated by Mizikovsky (US Patent Number 5,559,860).

Regarding **claims 1 and 14**, Mizikovsky discloses a method and apparatus for generating a reminder in a communication device (mobile station 10); see Figure 1. The apparatus includes an input device (for example keypad 42, audio input 16), at least one memory (46, 47), and a processor (40, 44, 36, 38; column 13, lines 19-24) as claimed.

The method includes a user generated reminder (text or audio), that will be presented, displayed, or played ("action" as claimed) to the user upon an external triggering event (incoming call that is received); see the abstract, column 6, lines 20-25, and column 8, lines 50-65.

In detail, the method includes:

generating the reminder from user input (for example using keypad 42) and storing the reminder in the system (for example in memory 46); see column 6, lines 7-43.

Defining an external triggering event (for example an incoming call), and storing an indication (for example "selected telephone numbers corresponding to calling party telephone numbers") of the external triggering event in the system; see abstract, column 2, lines 31-37, column 4, lines 45-64, column 6, lines 20-25, column 8, lines 8-19 & 50-65, and column 9, lines 34-45.

It is clear that the triggering event (incoming phone call) occurs external to the communication device 10. Since both the indication and the reminder are stored in the same unit, they are "indexed together, once stored, in the communication device" as claimed.

Defining an action (presenting a pre-programmed response/message/indication/reminder, displaying a text message, or playing an audio indication) and storing an indication of the action in the system, the action associated with the reminder and the action, once stored, indexed

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together with the triggering event and the reminder; see the abstract, column 8, lines 1-20, and above citations.

Detecting at the communication device occurrence of the external triggering event (this is when an incoming call is received); see the abstract and above citations.

Performing, in response to detecting the triggering event (incoming call), the action (output, display or play the pre-programmed message), associated with the reminder (text or audio), at the communication device (10); see above citations.

Regarding **claims 2-5, 10-13, 15-18, 23-26**, Mizikovsky discloses everything claimed as applied above (see *claims 1 and 14*). In addition, as explained above Mizikovsky teaches that the reminder can be a text reminder (telephone number, name, organization, location, etc.) generated by user input at keypad 42; see column 4, lines 45-64, and column 6, lines 20-25.

The reminder can also be an audio reminder generated by user recording at voice input 16; see column 8, lines 50-65, column 13, lines 1-8, *inter alia*.

The communication device includes a “triggering-event-detecting device” (combination of 36, 40, 47, 44) for detecting the occurrence of the external event (incoming call); see Figure 1. As explained by Mizikovsky, “when an incoming call is received at the mobile station, the calling party's telephone number is compared with the stored telephone numbers, previously programmed by the user, to detect an incoming call from a particular calling party. Depending upon the response category assigned to incoming calls from that particular calling party, the selected response is initiated.” – abstract.

As explained above the “action” can be to display the text reminder or to play the audio reminder; see above citations.

As explained above the reminder, the indication of the triggering event and the indication of the action are stored in the communication device (see rejection of claims 1 and 14 above); see memory 46, 47.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 6-7 and 19-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizikovsky (U.S. Patent Number 5,559,860) in view of Johnson et al. (U.S. Patent Number 5,664,063).

Regarding **claims 6-7 and 19-20**, Mizikovsky discloses everything claimed as applied above (see *claims 1 and 14*). However, Mizikovsky fails to specify that the “reminder” could be a video reminder as defined by applicant.

Johnson et al. discloses a method for automatically reminding a remote communication device user of certain events. The user generates the reminder by specifying an audio segment or a video message reminder, as disclosed at column 4, lines 42-53, column 5, lines 15-31, and in the abstract. The advantage of a video reminder is that it provides enhanced and more comprehensive information for the user of the communication device, which is more attractive for certain consumers.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a video reminder or a video reminding function as taught by

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Johnson et al. in Mizikovsky's communication device (10) because this would provide enhanced and more comprehensive information to the user; therefore better marketing possibilities for the manufacturer.

Response to Arguments

9. Applicant's arguments with respect to all pending claims have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

10. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 703-305-0078. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika A. Gary, can be reached on (703) 308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ELISEO RAMOS-FELICIANO
PATENT EXAMINER
ERF/erf
March 19, 2004.


ERIKA GARY
PATENT EXAMINER